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PATENT TRADEMARK OFFICE

PATENT

Customer No. 22,852

Attorney Docket No. 5725.0834-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michel PHILIPPE *et al.*

Application No.: 09/770,473

Filed: January 29, 2001

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) Group Art Unit: 1617
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) Examiner: M. Willis
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For: USE OF POLYAMINO ACID DERIVATES TO TREAT
SEBORRHEA AND THE ASSOCIATED SKIN DISORDERS

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE

In reply to the Office Action dated October 22, 2002, the period for reply having been extended for one month by a request for extension and fee payment filed concurrently herewith, please reconsider the application in light of the following remarks.

A. Status of Claims

Claims 1-59 are currently pending in the application. Claims 1-30 stand rejected, and claims 31-59 were withdrawn from consideration by the Examiner.

B. Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 1, 4, 5, 10, 12, 13, 16, 17, and 21-24 stand rejected under 35 U.S.C.

§ 112, second paragraph as indefinite. Specifically, the Examiner states that the instant claims are indefinite because "the use of hydrocarbon-based radical as including heteroatoms and components other than hydrogen and carbon is repugnant to the art."

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(Office Action, p. 2 line 17 - page 3, line 1). Applicants respectfully traverse the rejection with respect to all claims.

The test of whether a claim meets the requirements of definiteness under 35 U.S.C. § 112, second paragraph, is whether the claim language is clear and precise, not whether more suitable language or modes of expression are available. Such an inquiry must take into consideration: 1) the content of the disclosure; 2) the teachings in the art; and 3) the interpretation that would be given to the claim by one skilled in the art. A claim should not be rejected because an Examiner prefers language other than that used by the applicant. M.P.E.P. § 2173.02. Furthermore, an applicant is permitted to use his own terminology, as long as it can be understood. M.P.E.P. § 608.01(g).

Applicants have used the term "hydrocarbon-based radical" in a consistent manner throughout the specification. Therefore, the question is whether the meaning of the term would be understood by one skilled in the art, taking into consideration the teachings in the art.

Applicants respectfully contend that the teachings in the art are not at all inconsistent with the way in which Applicants have used the term "hydrocarbon-based radical." Applicants respectfully contend that describing alkyl chains, which may be optionally substituted with heteroatoms, as "hydrocarbon-based" is not "repugnant to the art." The use of the term "hydrocarbon-based" tells one skilled in the art that the described alkyl chains are "based" on carbon and hydrogen. The fact that Applicants use the term "based" to modify the term "hydrocarbon" tells one of skill in the art that such chains contain carbon and hydrogen, but may optionally contain other atoms as described in the specification and claims. The Examiner has pointed to no evidence

supporting the allegation that one skilled in the art would not understand the way in which Applicants have written their claims or that such a definition is repugnant to the meaning of the term "hydrocarbon-based" as found in the art. Therefore, the present claims meet the definiteness requirement of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejection be withdrawn for all claims.

C. Rejections under 35 U.S.C. § 102(b)

Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,886,041, to Yu et al. Specifically, the Examiner states that Yu discloses compositions for the treatment of skin disorders such as acne and that Yu Examples 6, 15, and 18 contain either beta-ala-L-his or glycinyglycine, compounds that allegedly fall within the general formula defined in independent claim 1. Applicants respectfully traverse the rejection with respect to all claims because the disclosure of Yu does not teach or suggest all the elements of the present claims and therefore does not properly anticipate them.

Under 35 U.S.C. § 102(b), a claim is anticipated only if *each and every* element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. M.P.E.P. § 2131. In this case, the Examiner has failed to show the disclosure of Yu constitutes a sufficient disclosure of the present invention to constitute an anticipatory reference.

Yu generally describes compositions to alleviate cosmetic conditions and symptoms of dermatologic disorders, comprising alpha-hydroxyacids, alpha ketoacids, and polymeric forms of hydroxyacids. Examples 6, 15, and 18 are directed to the

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preparation of compositions containing hydroxypropanoic derivatives and beta-alanine-L-histadine or glycine-glycine.

In contrast, the present claims are directed to *methods of treating* skin conditions with compositions containing polyamino acid derivatives. Furthermore, none of Examples 6, 15 or 18 of Yu describe the application of a composition for the treatment of at least one skin condition chosen from seborrhea of the skin and scalp, and disorders associated with microorganisms of the genus *Propionibacterium*, as recited in independent claim 1. Furthermore, Applicants respectfully point out that the compound beta-ala-L-his is an example of a beta-amino acid that does not fall within the genus of compounds described in claim 1. Accordingly, neither the disclosure of Yu, nor specific Examples 6, 15 or 18 of Yu anticipate independent claim 1 under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully request that this rejection be withdrawn for all claims.

D. Rejections under 35 U.S.C. § 103(a)

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu. Specifically, the Examiner states that Yu teaches the use of dipeptides for the treatment of skin disorders and the use of short-chain polypeptides containing up to 100 amino acids for the same purpose. The Examiner states that it would have been obvious to one of ordinary skill in the art to have modified the teachings of Yu to use a variety of dipeptides, tripeptides, and short-chain polypeptides to treat the skin conditions that are the subject of the instant claims. Applicants respectfully traverse the rejection as failing to establish a prima facie case of obviousness.

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In order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the Examiner must at least point to some specific teaching or motivation contained in the art that would have motivated one skilled in the art to modify the reference in order to arrive at the claimed invention. Such teachings and motivations are absent in Yu.

The disclosure of Yu is concerned primarily with compositions comprising "amphoteric compounds," alpha hydroxyacids, alpha ketoacids, and polymeric forms of hydroxyacids to treat cosmetic conditions and dermatological disorders. According to Yu, among the "amphoteric compounds" that may be used are "amino acid type amphoteric," as well as "imidazoline and lecithin amphoteric," and "pseudoamphoteric and miscellaneous amphoteric." Among the skin conditions which Yu discloses may be treated with the compositions include dry skin, dandruff, acne, keratoses, psoriasis, eczema, pruritus, age spots, lentigines, melasmas, wrinkles, warts, blemished skin, hyperpigmented skin, hyperkeratotic skin, inflammatory dermatoses, skin changes associated with aging and as skin cleansers. Column 3, lines 19-27.

The Examiner, in an attempt to arrive at the instantly claimed invention, has independently chosen the required elements from the multitude disclosed by Yu. There is no basis in Yu for choosing the particular elements required to arrive at the instantly claimed invention. For example, the Examiner states that it would have been obvious to one skilled in the art to choose polyamino acids from among the many thousands of "amphoteric" compounds described by Yu; Yu, however, indicates no preference of these acids over the other compounds. Furthermore, the Examiner states that it would have been obvious to choose to treat skin conditions associated with seborrhoea of the

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skin and scalp with such compositions from the multitude of conditions disclosed by Yu; Yu, however, discloses no preference for this condition over the other conditions.

The Examiner has failed to point to any particular teachings or suggestions in Yu, and Applicants respectfully submit that none exists, that would have led one skilled in the art to choose the particular limitations contained in the instant claims. In failing to specifically cite such a teaching or suggestion, the Examiner has simply chosen from among these variables using impermissible hindsight and Applicants' claims as a blueprint. Therefore, the Examiner has failed to create a proper prima facie case of obviousness. Accordingly, Applicants respectfully request that the rejection be withdrawn with respect to all claims.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 30, 2003

By: 
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